

Remarks

Before addressing the specific hypothetical examples set forth to the examiner in support of the restriction requirement, applicant respectfully notes that the test for whether groups of inventions are “distinct” is a two prong test: The term “distinct means that two or more subjects as disclosed are related...but are capable of separate manufacture, use, or sale as claimed, **AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER**”. MPEP 802.01. (emphasis in the original)

The examiner has asserted that the inventions of group 2 and the inventions of groups 1, 3, 5 and 6 are related as process and apparatus for the practice of the process. The examiner has further asserted that the inventions are distinct if it can be shown either that the process as claimed can be practiced by another materially different apparatus or by hand or that the apparatus as claimed can be used to practice in other materially different process, and in support of that contention has cited MPEP 806.05(e). The examiner is further asserted that in this case, the apparatus as claimed “can be used to practice and other materially different process such as one that cures or heat treats a plastics material”.

Applicant respectfully submits that this is incorrect. For apparatus to “cure” or “heat treat” plastic material and to do so in a manner differs more than semantically from “drying” the plastic material, the apparatus would have to operate on or process the “plastic material” after that material had been molded. To “process” such plastic material prior to molding or extrusion and to assert that such pre-molding processing by drying differs from curing or from heat treating, is nonsensical. When plastic resin material is in the pre-molded or pre-extruded state, it is granular in form and drying, heating and/or curing the granular material effectuate essentially the same thing--removal of moisture from the granular resin material, preparing the material for

processing by molding or extrusion into a finish or semi-finished product. Hence, the examiner's contention that the apparatus as claimed could be used to practice "another and materially different process" is incorrect since drying, curing and heat treating granular plastic resin material **prior to** molding or extrusion are not processes which are "materially different" one from another. This being the case, the examiner's showing of alleged distinctiveness as between the inventions of group 2 and the inventions of groups 1, 3, 5 and 6 is technically flawed and incorrect and, accordingly, the restriction requirement therebetween should be withdrawn.

In further support of that portion of the restriction requirement, the examiner has asserted that the inventions are distinct if it can be shown that the process as claimed can be practiced by another materially different apparatus or by hand. The examiner made **no** such showing and, accordingly, applicant again submits that the rationale for the examiner's contention of distinctness as between the inventions of group 2 and the inventions of groups 1, 3, 5 and 6 is erroneous and cannot support the restriction requirement as stated. Reconsideration and withdrawal of the restriction requirement as between the inventions of group 2 and the inventions of groups 1, 3, 5 and 6 is respectfully solicited.

Respecting the requirement for restriction between the inventions of groups 2 and 4, the examiner has asserted that the inventions of these two groups are related as subcombinations disclosed as being usable in a single combination. The examiner further asserted that these subcombinations are distinct from each other if they are shown to be separately usable. The examiner has still further asserted that in the instant case, the inventions of group 4 have separate utility such as for "drying a food product or cereal".

Applicant believes the examiner's characterization of the claims of groups 2 and 4 as being related as **subcombinations** disclosed as being usable together is incorrect. The claims of

group 2 are directed to a method for molding plastic into finished products. Those method claims involve mixing plastic material components, drying mixed plastic material components and molding the mixed dried components. The claims of group 4 are directed solely to a drying method which could be used as an aspect of the method defined by the claims of group 2. Accordingly, the proper characterization of the claims of group 2 vis-à-vis the claims of group 4 is that the claims of group 4 are a possible subcombination of the claims of group 2.

Applicant can concede that the claims of group 4 may have separate utility such as being used for drying some other granular products such as a food product or cereal.

In support of his distinctiveness position the examiner cited MPEP 806.05(d) which states that two or more claimed subcombinations which are disclosed as being usable together in a single combination “are usually distinct from each other” if they can be shown to be separately usable. It should be specifically noted that MPEP 806.05(d), on which the examiner based his distinctness position, addresses only the “separately usable” first prong of the two prong test for distinctness; **MPEP 806.05(d) is silent respecting the second prong of the distinctness test, namely whether the inventions defined by the claims at issue are patentable over each other.** The examiner made no such finding respecting the requirement for restriction as between the claims of group 2 and group 4. Lacking such a finding, the restriction requirement as between claim groups 2 and 4 is unsupportable and should be withdrawn.

The examiner asserted that the inventions of groups 1 and 3 are related as a combination and subcombination and asserted distinctness as between these two groups if it could be shown that the combination as claimed does not require the particulars of the

subcombination as claimed for patentability and that the subcombination has utility by itself or in other combinations. In support of this, the examiner cited section 806.05 (c) of the Manual of Patent Examining Procedure. In further support of this distinctness position, the examiner asserted that the combination as claimed, namely the claims of group 1, does not require the particulars of the subcombinations namely the claims of group 3 as claimed because the combination does not require a means for selectively sealing material in a drying zone, a manifold means, a canister or canisters or a rotatable carousel.

The examiner did not demonstrate that the claims of group 1 do not require the particular limitations of group 3 for patentability.

The first prong of the distinctness test cited by the examiner is whether the combination as claimed requires the particulars of the combination as claimed for patentability. The test is not whether the combination is claimed requires the particulars of the subcombination for **operability**, the issue is whether the combination as claimed require the particular of the subcombination as claimed for **patentability**. The examiner **made no showing** of whether the combination as claimed does, or does not, require the particulars of the subcombination for patentability. The examiner has only asserted that the combination as claimed does not require the particulars of the subcombination, but did not make any assertion as why the combination as claimed allegedly does not require for whatever purpose, the particulars of the subcombination. In other words, the examiner failed to address the required patentability prong of the distinctness test under 806.05(c) of the Manual of Patent Examining Procedure. Since the examining attorney failed to address the first of the two required prongs of the test for distinctness regarding the inventions of group 1 and 3, the restriction requirement as

between groups 1 and 3 is not well-founded; it should be reconsidered and withdrawn.

Notification of the same is respectfully solicited.

In this regard, it should be noted that applicant does not dispute the examiner's assertion regarding the second prong of the distinctness test under 806.05(c) of the Manual of Patent Examining Procedure, namely that the subcombination, namely the claims directed to the dryer, may have separate utility other than for use in a plastic material processing system with such separate utility being, for example, use in processing a food product or cereal. However, applicant does not believe that the dryer of the invention, as disclosed in the instant application, could be used to cook or bake a food product or cereal as speculated by the examiner; applicant believes that the utility of the invention defined by the claims of group 3 is limited to drying granular products such as cereal, other food products, plastic resin and the like.

In support of the restriction requirement between the claims of groups 1 and 4, the examiner has asserted that the inventions of group 1 and 4 are unrelated. In support of this, the examiner has cited 806.04 the Manual of Patent Examining Procedure and asserted that groups of inventions are unrelated if it can be shown that the groups are not disclosed as capable of use together and the groups have separate modes of operation, different functions or different effects. In further support of the distinctness position, the examiner has asserted that in the instant case different inventions have different modes of operation such as molding a plastic material and drying a powdery or granular material such as a food product or cereal.

Applicant respectfully submits that the examiner has misread the claims of group 1 and group 4. The claims of group 1 are directed to a plastic material processing system, one

component of which is a dryer. The claims of group 4 are directed to a method for drying. It surely is the case that the inventions of groups 1 and 4 are disclosed as capable of use together. Hence, the inventions of groups 1 and 4 are related, the examiner's position to the contrary notwithstanding.

Moreover, to assert that the inventions of group 1 and 4 have different modes of operation, different functions or different effects as required by section 806.04 of the Manual of Patent Examining Procedure cited by the examiner is illogical. The drying method defined by the claims of group 4 are methods for performing one of the functions, namely drying, which is a step that must be performed during operation of the plastic material processing system defined by the claims of group 1. Hence, the inventions defined by the claims of group 4 have modes of operation, functions and effects which are congruent with one of the component elements of the claims of group 1.

This being the case, it is incorrect and illogical to contend that the inventions of the claims of groups 1 and 4 are unrelated since they have different modes of operation, different functions or different effects, as asserted by the examiner. Specifically, the examiner has asserted that the different inventions "have different modes of operations such as molding a plastic material and drying a powder or granular material such as a food product or cereal". This begs the question since to perform molding of plastic material, it is necessary that the plastic material first be dried in order for the molding to be successful. The proper characterization of the claims of groups 1 and 4 is that the claims of group 4 are directed to a method which must be practiced by one of the elements of the claims of group 1 in order for those group 1 claims to operable. This being the case, it certainly cannot be reasonably

contended that the claims of group 1 and group 4 are unrelated. In light of this, applicant respectfully solicits reconsideration and withdrawal of the restriction requirement as between the claims of groups 1 and 4.

The examiner asserted that the inventions of groups 1 through 3 and 4 were related as subcombinations disclosed as being usable together in a single combination. The examiner then contended that the subcombinations “are distinct from each other if they are shown to be separately usable.” Notably, the examiner made **no reference whatsoever** to the second prong of the distinctness test, namely whether the inventions defined by each one of the separate groups of claims are novel and unobviously patentable respecting the other groups of claims.

The examiner has asserted that the inventions of group 1 and of groups 4 and 5 are unrelated. In support of this position, the examiner has asserted that groups of inventions are unrelated if it can be shown that the groups are not capable of use together and the inventions have different modes of operation, different functions or different effects; in support of this the examiner cited Sections 806.04 and 808.01 of the Manual of Patent Examining Procedure. In further support of this unrelatedness position, the examiner has stated that “in the instant case the different inventions have different modes of operations such as molding of plastic material and the transportation a powdery/granular material”..

Applicant respectfully traverses that this position on unrelatedness of the groups of inventions and requests reconsideration. It is surely the case that the inventions of groups 1, 5 and 6 have been disclosed as being capable of use together. The specification of the patent application clearly discloses the plastic material processing system, discloses the manner in which the canister (to which the claims of group 5 are directed) works in the dryer which

performs a necessary, integral function in the course of operation of the plastic material processing system and discloses the manner in which the take-off assembly (to which the claims of group 6 are directed) operates to deliver the dried granular material from the dryer to the molding machine thereby facilitating operation of the plastic material processing system (to which the claims of group 1 are directed). Clearly, the inventions defined by the claims of groups 1, 5 and 6 have been disclosed as being capable of used together, the examiner's assertion to the contrary notwithstanding. This being the case, the inventions defined by the claims of groups 1, 5 and 6 are related and, accordingly, the basis for the restriction requirement as among the inventions of claims 1, 5 and 6 is not well-founded. Therefore, this position of the restriction requirement should be reconsidered and withdrawn.

In requiring restriction between the claims of groups 3 and 4, the examiner asserts that these claims are related as being directed to a process and apparatus for practice of the process. In asserting distinctness as between the claims of group 3 and 4, the examiner has asserted that the claim groups are distinct if it can be shown that the process as claimed can be practiced by another materially different apparatus or by hand or if it can be shown that the apparatus as claimed can be used to practice another materially different process. In support of this the examiner has cited Section 806.05(e) of the Manual Patent Examining Procedure. In support of the restriction requirement, the examiner then contends that the apparatus as claimed can be used to practice another materially different process such as cooking or baking a food product or cereal. Applicant traverses this position and requests reconsideration of the same.

THE REQUIRED SCOPE OF THE SEARCH

The most salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee:

The director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the director shall issue a patent therefor. 35 U.S.C. 131

Restriction is proper only where an examiner would be unduly burdened by searching numerous, unrelated inventions or technologies. The scope of a search for related inventions, even though possibly burdensome, cannot by itself justify restriction of related inventions. If an application includes claims to related inventions which are distinct or independent inventions, the examiner **must** examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner:

If the search and examination of **an entire application** can be made without serious burden, the examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions**. MPEP 803.

In developing a search strategy and mapping the scope of a search, claims are to be given their broadest reasonable interpretation, both literally and by equivalents:

All subject matter that is the equivalent of the subject matter as defined in the claim, even through specifically different from the definition in the claim, must be considered unless expressly excluded by the claimed subject matter. MPEP 904.01(b)

The examiner will not be unduly burdened by searching and examining all of the claims presented by applicant in a single application. The examiner's search will not be narrowed or

reduced by compliance with the restriction requirement, since applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the disclosed apparatus and methods as evidenced by the claims in the application.

The examiner's instructional guidelines for performing a search for any application are set forth in the MPEP. The guidelines require the examiner to search in classes and subclasses in which arguably distinct (as defined by the MPEP) inventions would be classified:

"Not only must the art be searched with which the invention claimed is classifiable, but **also all analogous arts regardless of where classified.**

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. MPEP 904.01(c) (emphasis added).

A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified...

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, **that may have material pertinent to the subject matter as claimed.** Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. **The search should extend to all probable areas relevant** to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed. MPEP 904.02(a) (emphasis added).

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action ... It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; **but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.** MPEP 904.03, ¶ 1 (emphasis added)

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her

invention, by showing that this other subject matter is old or obvious. MPEP 904.03 ¶ 2

In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure... MPEP 904.03 ¶ 3.

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

(1) Classes and subclasses in which the claimed subject matter is classified; this means that classes and subclasses in which functional modules and power bus backplanes are classified must be searched;

(2) Classes and subclasses that may have material pertinent to the claimed subject matter; this means that classes and subclasses having material pertinent to functional modules and power bus backplanes, such as devices for connecting modules to power bus backplanes, must be searched;

(3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; this means designs for such modules and power bus backplanes must be searched; and

(4) Classes and subclasses that may contain subject matter disclosing material related to features which might reasonably be expected to be claimed; this means classes for particular power bus bars must be searched.

The Proposed Restriction Would Be Unduly Economically Burdensome On Applicant

While the Patent and Trademark Office has a legitimate interest in obtaining proper revenue from filing, issuance and maintenance fees, it does not have unrestrained power to tax inventors or the entrepreneurial enterprises employing them. Applicant is entitled to obtain patent protection on each of the nonobvious inventive aspects of the subject matter which applicant has disclosed. If the applicant is forced to divide this application into six separate patent applications as suggested by the examiner, this will be unduly and unfairly burdensome

to the applicant due to the extra fees and costs associated with prosecuting five more patent applications and maintaining five additional patents.

Table 1 sets forth the divisional application filing costs which would be incurred by the applicant in the event the restriction requirement stands:

TABLE 1: DIVISIONAL APPLICATION FILING COST

Group Number	I	II	III	IV	V	VI
Independent Claims	1	1	8	3	1	1
Excess Independent Claims	0	0	5	0	0	0
Excess Independent Claim Fee	\$0	\$0	\$215.00	\$0	\$0	\$0
Total Claims	1	3	31	4	2	1
Excess Claims	0	0	11	0	0	0
Excess Claims Fee	\$0	\$0	\$99.00	\$0	\$0	\$0
Basic Filing Fee	\$385.00	\$385.00	\$385.00	\$385.00	\$385.00	\$385.00
Total Filing Fee	<u>\$385.00</u>	<u>\$385.00</u>	<u>\$699.00</u>	<u>\$385.00</u>	<u>\$385.00</u>	<u>\$385.00</u>

Total of All Filing Fees \$2,624.00

Already Paid by Applicant at Filing	\$ 800.00
Already Paid by Applicant to Add Claims 26-42	\$ 237.00
Filing & Claims Fees Paid by Applicant to Date	\$1,037.00

As can be seen from Table 1, applicant will be forced to pay additional filing fees in the amount of \$2,239.00 to file five (5) divisional applications in the event the restriction requirement is not withdrawn.

As further indicated on Table 1, applicant has already paid \$1,037.00 in filing and claims fees to date. If applicant is forced to adhere to the restriction requirement, some of this will be forfeited since seven independent claims and 11 claims in total will not be examined in the instant application despite the fact that applicant has paid the fees therefor. Indeed, applicant will be forced to pay \$2,239.00 additional to secure examination of the seven extra independent claims and the 11 total extra claims, for which applicant has already paid. Hence, applicant will incur an initial, non-recoverable penalty of \$2,239 (\$385.00 + \$699.00 + \$385.00 + \$385.00 + \$385.00) in the event applicant is required to adhere to the outstanding restriction requirement and file divisional applications for the five non-elected groups of claims.

Applicant further notes that the figures given in Table 1 do not include attorney fees, associated costs and expenses. The attorney fees associated with filing each such divisional patent application will probably be around \$1,000.00; this figure is taken by analogy from the figure appearing in the AIPLA Report of Economics Survey 2003 for the filing of a patent application as a PCT application in the United States as the receiving office where the patent application filed was based on either a previously prepared U.S. patent application as the PCT application or was a foreign origin PCT application.

Furthermore, applicant will be faced with preparing amendments and arguments in response to official actions to be issued by the United States Patent and Trademark Office. Again based on the AIPLA Report of Economic Survey 2003, from figures given for the costs to prepare an amendment and argument of minimal complexity, it can be expected that the applicant will face fees of in the neighborhood of \$2,200.00 for each amendment and argument

which may be required in response to an official action. Additionally, there will be attorney fees associated with the payment of any issue fee if allowed claims are obtained and this will amount to about \$700.00 per application, again based on the AIPLA Report of Economic Survey 2003. Add to this fees for the preparation and filing of information disclosure statements, and the ordinary and routine reporting letters to the client, the result is that the attorney fees associated with the filing and prosecution of five (5) divisional applications could easily amount to \$7,000.00 or \$8,000.00 per application, leading to a further incremental cost to the applicant from \$30,000.00 to \$40,000.00 if the restriction requirements stands.

Applicant further submits that the restriction requirement will be further burdensome on applicant since it is expected that off-shore patent offices will likely follow any lead of the United States Patent and Trademark Office in requiring restriction of the counterpart pending foreign applications. It is quite common for foreign patent offices to inquire as to the action(s) taken by the United States Patent and Trademark Office in connection with the counterpart U.S. priority application, especially where the inventor is a citizen of the United States and, as a result, the U.S. application is timewise ahead of the foreign applications in actual filing date and prosecution activity. Applicant has filed counterpart foreign applications including in the European Patent Office and in Canada. If the European Patent Office and the Canadian Patent Office consider the action of the U.S. patent examiner to establish a restriction precedent for the counterpart European and Canadian patent applications, applicant will be further economically penalized by being forced to pay additional filing, prosecution, issue and maintenance fees in Europe and Canada for patent protection for the instant invention. This is another reason mandating reconsideration and withdrawal of the restriction requirement.

Table 2 presents the patent issue fees and maintenance costs applicant will face in the event the restriction requirement stands and applicant is successful in prosecuting the parent application and five divisional applications to allowance:

TABLE 2: PATENT MAINTENANCE COST

Number of Patents	1	2	3	4	5	6
Issue Fee	665.00	1,330.00	1,995.00	2,660.00	3,325.00	3,990.00
1 st Maintenance Fee	455.00	910.00	1,365.00	1,820.00	2,275.00	2,730.00
2 nd Maintenance Fee	1,045.00	2,090.00	3,135.00	4,180.00	5,225.00	6,270.00
3 rd Maintenance Fee	<u>1,610.00</u>	<u>3,220.00</u>	<u>4,830.00</u>	<u>6,440.00</u>	<u>8,050.00</u>	<u>9,660.00</u>
TOTAL	\$3,775.00	\$7,550.00	\$11,325.00	\$15,100.00	\$18,875.00	\$22,650.00

Even from Table 2, which presents the maintenance fee costs at today's, January 2004, levels, it is apparent that applicant will face issue and maintenance fees amounting to \$18,875.00 extra, over and above the cost to issue and maintain a single patent directed to the invention, if the restriction requirement stands. When this figure is combined with the figures discussed above, the total financial penalty applicant potentially faces in just official fees amounts to \$21,114.00 as a result of the restriction requirement. Applicant respectfully submits that applicant should not be burdened in this manner and that the restriction requirement should be reconsidered and withdrawn in its entirety.

**The Patent Office's Responsibility Is Public Service,
Not Revenue Generation**


While applicant recognizes the Patent and Trademark Office interest in obtaining proper revenue from filing and issuance fees, the Patent and Trademark Office is not in the business of assisting the IRS in financing the government. The sole function of the Patent and Trademark Office is to serve inventors and the public in an efficient and expeditious manner. The Patent and Trademark Office is charged with a duty to carry out its responsibility of examining patent applications thoroughly and efficiently. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search, as contrasted to six largely, if not completely, overlapping searches of the classes defined by the examiner in levying the erroneously-based restriction requirement.

Reconsideration and withdrawal of the restriction requirement is again respectfully solicited.

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of this paper and/or any accompanying papers submitted herewith, please charge all such fees to Deposit Account 50-1943.

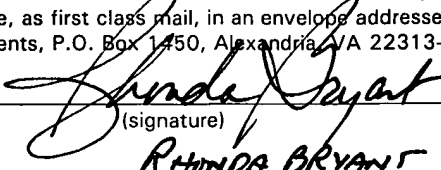
Respectfully submitted,

Date: 16 JANUARY 2004


CHARLES N. QUINN
Registration No. 27,223
Attorney for Applicant

Fox Rothschild LLP
2000 Market Street, 10th Floor
Philadelphia, PA 19103
Tel: 215-299-2135

Fax: 215-299-2150
email: cquinn@foxrothschild.com

<p style="text-align: center;">CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)</p> <p>I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p style="text-align: center;"> (signature)</p> <p>BY: <u>RHONDA BRYANT</u></p> <p>DATE: <u>JANUARY 16, 2004</u></p>

